

REMARKS

Claims 36-59 are presently pending. Claims 48 and 55 have been amended. Claims 1-35 were canceled previously.

Applicant respectfully requests reconsideration of the claims in view of the foregoing amendments and the remarks appearing below.

Objection to Claims

The Examiner has objected to claims 44 and 55 because of the informality that each of these claims includes the word "facilitation" when, in fact, it appears that the correct word should be "facilitator."

Applicant agrees and has amended claims 44 and 55 accordingly. Therefore, Applicant respectfully requests that the Examiner withdraw the objection.

Rejections under 35 U.S.C. § 112, First Paragraph

Lack of Concreteness/Usefulness of Results

The Examiner has rejected claims 35-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner essentially asserts that the information set forth by participants is subjective and varies from situation to situation. Therefore, the Examiner asserts, the claims contain subject matter that is not described in the specification in such a way as to enable one skilled in the art to use the invention. Further, the Examiner asserts that the subjective analysis and interpretations of the participants do not allow for useful and concrete results. Applicant respectfully disagrees.

Applicant respectfully submits that this rejection is premised upon misapplication of several points of law. First, in a method having steps that by necessity have one or more "users" providing situational input so as to achieve correspondingly situational output, it is not incumbent on an applicant to enable the output, which the Examiner is calling "different results." This would be a virtually impossible standard to meet. In the present application, e.g., independent claim 36 is directed to facilitating conception of an invention. It would not be possible for Applicant to enable every situational result for the simple reason that the method is meant to be performed by many different groups of people in many different settings for many

years to come. For Applicant to enable the results of the method would require Applicant to be omniscient and foresee the future.

To the contrary, Applicant need only enable the use of the method that produces the various results. Furthermore, Applicant need only enable those having ordinary skill in the art. The level of skill of one who would be performing the method of claim 36 is generally relatively high and is the level of skill of someone having ordinary experience in creating thinking. It should be apparent that such skilled artisan will surely understand how to carry out each and every one of the steps of the present claims. Again, the fact that the responses of the participants will be different from situation to situation is not relevant to whether or not the claims have been properly enabled.

Applicant asserts that this position is supported by the U.S. Patent and Trademark Office. For example, the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," Commissioner for Patents, USPTO (October 26, 2005), state in section IV.C.2.b(3) regarding concreteness of results that "concreteness" goes to the repeatability and predictability of the results. In fact, the Guidelines state that the opposite of "concrete" is "unrepeatable" or "unpredictable." The Guidelines go on to state that resolving the question of concreteness is dependent on the level of skill in the art. If the claimed invention is a process that requires a particular skill, "to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in the field." Guidelines, sec. IV.C.2.b(3).

In the present case, Applicant asserts that results of the method of the claims are concrete because they are not unrepeatable and are not unpredictable. Taking claim 36 as an example, each of the requesting steps produces the concrete result of at least one participant performing the corresponding task being requested. For example, step (a) requires the requesting of at least one participant to generate a plurality of mess statements. The result of this step is the at least one participant generating a plurality of mess statements. The act of generating the mess statements, and the statements themselves, are both "concrete" results because they are completely predictable and repeatable. That is, regardless of the invention being facilitated and, hence, regardless of the content of each mess statement, the performance of this step will always result in a plurality of mess statements being generated.

Again, concreteness does not go to the repeatability of the contents of the mess statements, as they will naturally vary from invention to invention and person to person. If concreteness did go to the content of the results, many claims that have issued for methods that produce different results depending upon inputs that vary would never have issued. Take for example claim 1 of U.S. Patent No. 5,190,458 to Driesener that is directed to a psychological method of assessing a persons character. Claim 1 reads in its entirety:

1. A method of phychological testing of a person, comprising:
 - (a) instructing the person to produce a drawing which includes at least on pictorial representation of each of at least a majority of the following items: a hand, an eye, a tree, a fish, a star, a spiral; [sic] a half-circle, and a zig-zag; and
 - (b) subjecting to psychological interpretation the drawing produced in response to step (a).

Applicant asserts that the contents of the results of this claim, i.e., the content of the interpretation of the drawing produced, is highly situational in the same manner that the content of the mess and other statements of claim 36 is highly situational. Again, however, concreteness does not go to the content of the interpetation and the statements of claim 36, but rather to the occurrence of the interpretation and generation of the statements. Otherwise, the U.S. Patent and Trademark Office surely would not have issued claim 1 of the Driesener patent.

Regarding usefulness, this criterion is addressed below in connection with the 35 U.S.C. § 101 rejection of the claims. However, to summarize, it is well-known that usefulness is directed to the utility requirement of 35 U.S.C. § 101 and that the utility requirement can be satisfied by any part of the application or even during prosecution. *See, e.g.*, Interim Guidelines, sec. IV.C.2.b(1) and MPEP § 2107. Applicant asserts that he has clearly shown the utility of the present claims and their results in at least the field of inventing.

Since the results of claims 36-59 are clearly useful and concrete and the claims enabled, Applicant respectfully request that the Examiner withdraw the present rejection.

Insufficient Detail

The Examiner has rejected claims 37, 46-51, and 53-58 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In particular, the Examiner states that the description, in the detailed description, relating to the generation of at least one

invention map is insufficient to enable one of ordinary skill in the art to generate such a map or program a computer to make such a map. Applicant respectfully disagrees.

Applicant asserts that FIG. 12 and the accompanying description of pages 21 and 22 of the present application are indeed sufficient to enable someone having ordinary skill in the relevant art to generate such an invention map and to write computer-executable instructions for generating such a map. FIG. 12 shows an invention map of a hierarchical format. The components of the map are simply statements of various specific types arranged and graphically presented to visually show their interrelationships with one another. These statements, e.g., seed statements, problem statements, element statements, limitation statements, and solution statements are statements that result from a directed, facilitator-led conception session of the present invention. In a computer implementation, these statements are typically stored in a database within corresponding respective fields. They are input into the database using the various user interfaces illustrated, e.g., in FIGS. 5-11. These figures and their accompanying description clearly describe to those having ordinary skill in the art what the statements are and how they relate to one another. In a non-computer implementation, these statements may be written on pieces of paper, a white board, etc. or stored in the memories of one or more people.

With the various statements needed to generate an invention map either stored in a database, human memory, etc. or written down in a useful manner (as is well known in the art), the details of generating a map, such as the map of FIG. 12, either by computer or by hand, are simple and straightforward and involve only retrieving the relevant statements for the session or portion of a session at issue, arranging the statements into a logical hierarchical order, and using graphical elements, e.g., lines, to visually illustrate how the various statements relate to one another. These are all such basic and well-known operations that anyone of ordinary skill in the relevant art could make an invention map with only the disclosure provided in the present application. It is a fundamental principle of patent law that a patent application does not need to disclose that which is well-known in the relevant art. Virtually all that is required for generating an invention map beyond the knowledge of how the statements interrelate with one another (which is provided by the present disclosure) are basic programming and layout skills.

Since no extraordinary skill is required to make an invention map of the present invention in light of the entire disclosure of the application, Applicant respectfully submits that claims 37,

46-51, and 53-58 are enabled. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

Lack of Written Description

The Examiner has rejected claims 50, 51, 57, and 58 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner asserts that the phrase "soliciting a plurality of participants" is unsupported in the specification. Applicant respectfully disagrees.

Although Applicant is not certain about the motivation for the rejection, Applicant starts with the fact that the word "soliciting" in the context of the present invention generally means "asking somebody for something." See the attached definitions and synonyms of "solicit." In this context, the meaning of "soliciting" is akin to "requesting," which is used in many of the existing and originally filed claims. As will be apparent to someone skilled in the art, someone (e.g., a human facilitator) or something (e.g., a suitably programmed computer system) must request the participant(s) to provide various statements, i.e., mess statements, problem statements, creativity-stimulating statements, etc. Thus, a human or computer requests, or "solicits," each participant to provide such statements. A large portion of the present application describes that a method of the present invention may be performed using a computer system where the participant(s) and/or facilitator(s) are located remotely relative to one another (picture, e.g. an online implementation performed over the Internet). In such cases, a computer must solicit responsive statements from the diversely located participants.

The present application explains the various types of statements solicited in explicit detail. Consequently, all that would be required for a programmer would be to provide a way to solicit (request) information from the participants. A programmer having ordinary skill in the art would readily know how to write computer code for such communication. This would require only well-known and common programming skills. Again, it is a fundamental principle of patent law that a patent application does not need to disclose that which is well-known in the relevant art. Providing code to transmit email solicitations, instant-messaging solicitations, and other automated solicitations are so well known that U.S. Patent Law does not require Applicant to explain exactly how the solicitation is implemented. Indeed, there are so many implementation variations that it would be impractical to describe each in detail.

In view of the foregoing, Applicant respectfully asserts that claims 50, 51, 57, and 58 meet the written description requirement. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

Lack of Credible Utility

The Examiner has rejected claims 36-59 under 35 U.S.C. § 112, first paragraph, as lacking credible or well established utility such that one skilled in the art would not know how to use the claimed invention. Applicant respectfully disagrees.

Prior to addressing the Examiner's assertion of lack of credible utility, Applicant respectfully asserts that the Examiner has not made a proper *prima facie* case of lack of utility. In making a *prima facie* case, the Examiner must "provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing." MPEP § 2107.02(TV). "Accordingly, the PTO must do more than merely question operability—it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." *Id.* (citing *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975)). In the present Office Action, the Examiner has not provided a single factual basis to support the naked assertion of lack of utility in numbered item 8 on page 6 of the present Office Action. If the Examiner continues the rejection in another Office Action, Applicant respectfully reminds the Examiner of the evidentiary requirements set forth in MPEP § 2107.02(TV) and the other requirements for finding a lack of utility. That said, Applicant nevertheless addresses this issue on the merits immediately below.

The purpose of the utility requirement "is to limit patent protection to inventions that possess a certain level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept" Interim Guidelines, sec. II.A. To satisfy the utility requirement, the claimed invention as a whole "must produce a 'useful, concrete and tangible result.'" *Id.* (citing *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373-74, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998)).

Taking claim 36 as an example, this claim clearly meets the usefulness/concreteness/tangibility test. This is so because the result of the method of claim 36, i.e., the various statements requested from the participant, are indeed useful, concrete, and tangible. Note particularly that the steps of claim 36 are a series of steps the interrelate in a very particular way. That is they direct the at least one participant through a very specific series of questions and

answers so as to facilitate the conception of an invention. (This is why the title of the application is "Network-Based System And Method For Facilitating Conception Of Inventions In a Directed Manner." [Emphasis added.]) When these steps are performed by a person having ordinary skill in the art, e.g., a facilitator having a background in creating thinking, the requests for responses and the responsive statements of the various steps are unquestionably useful in developing a particular invention. The usefulness of the invention even more plainly evident in claim 37 in which an invention map is generated from the statements elicited from the at least one participant in the steps of claim 36.

Concreteness of the results of claim 36 is addressed above in the response the rejection under 35 U.S.C. § 112, first paragraph, for lack of concreteness/usefulness.

Regarding tangibility, this part of the trilogy is to ensure that claims are not directed to abstract ideas. *See, e.g.*, Interim Guidelines, sec. IV.C.2.b(2) (stating that "[i]n other words, the opposite meaning of 'tangible' is 'abstract.'"). As also stated in this section of the Interim Guidelines:

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception

The judicial exceptions are 1) laws of nature, 2) natural phenomena, and 3) an abstract ideas. Clearly, the results of claim 36 (various statements made by at least one participate) and the results of claim 37 (an invention map) are not laws of nature or natural phenomena. They are also not just abstract ideas because they have practical application in the field of inventing. Again, the results of claims 36 and 37 are aids for developing inventions. Claims 38-59 have utility in much the same manner that the illustrated claims 36 and 37 have utility.

Because claims 36-59 have practical application when carried out by someone having ordinary skill in the art, they indeed meet the utility requirement. Therefore, Applicant respectfully request that the Examiner withdraw the present rejection.

Rejections under 35 U.S.C. § 101

The Examiner has rejected claims 36-59 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Examiner asserts that: there is no technology in claims 36-39 and 41-43; there is only trivial use of a computer in claims 40, 44, and 45; there is

no credible asserted utility for claims 36-59; and claims 36-59 do not produce a concrete result. Applicant respectfully disagrees.

Applicant asserts that all of these rejections are properly addressed by referring to the new Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility promulgated by the U.S. Patent and Trademark Office on October 26, 2005, in response to the recent BPAI decision in Ex parte Lundgren, Appcal No. 2003-2088, Application 08/093,516 (Precedential BPAI opinion September 2005). Since all of the rejections are interrelated as will become apparent from the following discussion, Applicant uses the following discussion to show that all of the present rejections under 35 U.S.C. § 101 are improper.

As the Examiner surely knows, there is now explicit precedential support for Applicant's position that the "technological arts" inquiry is not proper. *See, e.g., Ex parte Lundgren*, Appeal No. 2003-2088, Application 08/093,516 (Precedential BPAI opinion September 2005) and "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility," Commissioner for Patents, USPTO (October 26, 2005). Both the Ex parte Lundgren opinion and Interim Guidelines explicitly state that there is "currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." Ex parte Lundgren, p. 7. Based on this finding, the Lundgren Board went on to reverse the examiner's rejection premised on the "technological arts" test. *Id.*

Implicitly in the Lundgren Board's reversal of the examiner's finding of non-statutory subject matter and explicitly in the Interim Guidelines, the U.S. Patent and Trademark Office has set forth that the proper test for assessing subject matter eligibility is essentially a two-part inquiry of:

(1) determining if the subject matter falls under one of the judicial exceptions, i.e., is 1) a law of nature, 2) a natural phenomenon, or 3) an abstract idea; and

(2) if the subject matter does not fall under a judicial exception, determining whether the subject matter has a practical application, i.e., produces a useful, concrete, and tangible result. Aside from various details attendant each of these parts, the inquiry is as straightforward as it appears. Notably, this inquiry does not include the following tests previously expressed by various courts and Boards:

- (a) the "technological arts" test;
- (b) the Freeman-Walter-Abele test;

- (c) the “mental step” test;
- (d) the “human step” test;
- (e) the “machine implementation” test; and
- (f) the “*per se* data transformation” test.

See Interim Guidelines, Annex III.

The first part of the above-enumerated proper inquiry is essentially directed to preventing applicants from obtaining patent protection for subject matter that they may have been the first to discover, but did not invent (laws of nature and natural phenomena) or for subject matter that has no practical application (abstract ideas).

The second part of the inquiry is generally directed to ensuring that a process does indeed have a practical application. The courts have established that practical application is assessed by determining whether or not the subject matter produces a result that is useful, concrete, and tangible.

Although authority is somewhat thin on exactly what the “useful-concrete-tangible” trilogy requires, guidance is found in case law, which is broadly summarized in section IV.C.2.b of the Interim Guidelines. To paraphrase the Interim Guidelines, “usefulness” is directed to the utility of an invention. Utility is rarely not found and may be supported by parts of an application other than the claims. “Concreteness” goes to the repeatability of the result. The Guidelines state that the opposite of “concrete” is unrepeatable or unpredictable. In processes that require a certain level of skill for implementation, repeatability is assessed relative to the requisite level of skill of ordinary artisans in the relevant field. “Tangibility” goes to whether or not a real-world, i.e., practical, result is achieved. The Interim Guidelines caution that the “tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.” Interim Guidelines, at section IV.C.2.b.(2) (emphasis added).

The Rejected Claims Do Not Fall Within a Judicial Exception

Regarding the claims rejected in the present case, Applicants assert that under the first part of the proper inquiry each of the rejected claims does not fall within a judicial exception. For example, claim 36 is directed to a method of requesting a variety of statements from at least one participant in a specific manner so as to facilitate the conception of an invention in a directed manner. Unquestionably, this method is not a law of nature, nor a natural phenomenon. Nor is

this method, or any of the steps therein, an abstract idea. On the contrary, the method and steps explicitly recited have a clear practical application to the field of inventing, as anyone having ordinary skill in the art would instantly recognize. Indeed, this practical application is discussed and exemplified throughout the present application and is also clearly supported by the related patent applications that are incorporated into the present application in their entireties.

Therefore, claim 36 does not meet a judicial exception and passes the first part of the proper statutory subject matter inquiry.

The Rejected Claims Have a Practical Application

Applicants also assert that under the second part of the proper inquiry the rejected claims have a practical application. Again, taking claim 36 as an example, the method and steps of claim 36 indeed have practical application in the field of inventing.

In terms of the “useful-concrete-tangible” trilogy, the usefulness of the claimed invention is unquestionable. As discussed above relative to the rejections under 35 U.S.C. § 112, first paragraph, the claimed method and its practical result, i.e., various statements made in response to specific, targeted requests for those statements, have utility in the field of inventing.

Regarding concreteness, the practical result obtained by performing the method of claim 36, i.e., a set of statements made in response to the various requests, is a repeatable result regardless of how many times the method is performed and who performs the method. As discussed above in connection with the rejections under 35 U.S.C. § 112, first paragraph, although specific statements will virtually always vary from invention to invention and person to person, this is not the type of repeatability contemplated by the concreteness inquiry. If it were, any method that produces variable results, such as the variable compensation that is the result of the method of compensating managers at issue in the Lundgren case, would not be patentable. Indeed, there are many such methods patented, as evidenced above by the Driesener patent. The concreteness of the invention map of claim 37 is even more self-evident

Regarding tangibility, the method of claim 36 clearly produces a real-world, or practical result, i.e., a set of statements dealing with the conception of an invention that were elicited from the at least one participant by the directed requests of steps of the method. The set of such statements is of real-world value. The real world value of the invention map generated in claim 37 also has real-world value.

In view of the foregoing, claims 36 and 37 do have practical application and, therefore, pass the second and final part of the two-part statutory subject matter inquiry.

The Rejected Claims Are Directed to Statutory Subject Matter

Since claims 36 and 37 clearly pass both parts of the proper statutory subject matter inquiry as just demonstrated, claim 36 and 37 are statutory under 35 U.S.C. § 101. Using the same reasoning under the proper inquiry, all of the present claims are indeed statutory.

Rejections under 35 U.S.C. § 103

Hatton

The Examiner has rejected claim 36 under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 6,101,490 to Hatton, stating that Hatton discloses all of the limitations of this claim except (generally) the requesting of at least one participant to generate: 1) mess statements each corresponding to a respective goal of the at least one invention; 2) a plurality of data statements; 3) a plurality of first problems each containing a first problem to be solved; 4) a plurality of creativity-stimulating element statements; 5) generating at least one second problem statement; and 6) at least one solution to the second problem. The Examiner then asserts that claim 36 would have been obvious to a person having ordinary skill in the art at the time of the invention since all of the subject matter not disclosed by Hatton is nonfunctional descriptive material that does not distinguish the claimed invention from the prior art. Applicant respectfully disagrees.

Hatton discloses an expert system that receives as input English language statements and breaks them down so that they can be processed against "Experience Databases." The Experience Databases symbolically represent real-world systems in hierarchical format as a series of functions and processes. The Hatton expert system uses a selected Experience Database as a basis for making symbolic substitutions so as to develop analogies to the input statement.

Applicant respectfully disagrees that claim 36 is not patentable over the Hatton patent because the various statements in the "requesting" steps of claim 36 are nonfunctional descriptive material. Applicant respectfully asserts that the "requesting" steps of claim 36 must be considered in their entirety because each requesting step forms a unitary limitation. That is, the types of statements being solicited cannot be separated from the act of requesting those statements. Each requested statement has a specific functional purpose relative to the other

statements requested and the overall context of facilitating the conception of at least one invention. In particular, various steps of claim 36 require that certain statements directly follow from other statements because they are a function of the other statements. There is indeed a functional relationship among the various requests, which are unseparable from the specific types of responsorial statements being requested.

The U.S. Patent and Trademark Office's ban on nonfunctional descriptive material is not relevant to the patentability of claim 36. The ban on nonfunctional descriptive material is to prevent applicants from obtaining patent protection for such non-descriptive material *per se*. For example, an applicant could not get a patent on music, .e.g., contained on a compact disk. In this case, the music is considered nonfunctional descriptive material. However, if the music were created in a new, nonobvious way, an applicant could get a patent on a method of making the music. This situation is analogous to the present case. In the present case, Applicant is not attempting to patent a set of statements, i.e., the responses to the request of claim 36, *per se*, but rather is seeking a patent on a method of obtaining and using those responses. This method involves guiding at least one participant through a series of responsorials in a directed manner. Applicant respectfully asserts such a method is indeed patentable, as the above discussions of 35 U.S.C. §§ 101 and 112, first paragraph, demonstrate.

Since the steps of claim 36 are not directed to mere nonfunctional descriptive material, each step must be considered in its entirety against the references of record. Relative to the Hatton patent that the Examiner has applied, as the Examiner had admitted, Hatton does not disclose or even suggest virtually all of the limitations of claim 36. Applicant submits that it would be completely unreasonable to assert that claim 36 would be obvious in view of the Hatton patent and ordinary skill in the art. Other than its characterization as being in the field of creative problem solving, the Hatton subject matter has no tenable relation whatsoever to the invention of claim 36 in the context of the legal question of obviousness.

For at least the foregoing reasons, claim 36 is not obvious in view of the Hatton patent. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

Hatton and Smith, Jr.

The Examiner has rejected claim 37 under 35 U.S.C. § 103 as being obvious in view of the Hatton patent, discussed above, and U.S. Patent No. 5,662,478 to Smith, stating that Hatton discloses all of the limitations of claim 37 except for an invention map. The Examiner then

asserts that Smith, Jr. discloses an invention map and further asserts that a person having ordinary skill in the art at the time of the invention would have found it obvious to utilize the Smith, Jr. map with Hatton's expert system. Applicant respectfully disagrees.

The Hatton disclosure is discussed above relative to the rejection of claim 36 under 35 U.S.C. § 103.

Smith, Jr. discloses a map illustrating the process of creative problem solving and a method of using the map to lead people through the creative problem solving process.

First, Hatton fails to disclose or suggest all of the limitations of claim 36, which are also part of claim 37 by dependency. For this reason alone, the rejection is improper.

In addition, Smith, Jr. does not even remotely suggest an invention map, i.e., a visual representation of the responsive statements made by at least one participant in the context of invention conception. Again, the Smith, Jr. map is a map illustrating the Smith, Jr. view of the creative problem solving process. Further, the Smith, Jr. map has nothing whatsoever to do with mapping results, whereas the invention map of the present invention does.

For at least the foregoing reasons, claim 37 is not obvious in view of the Hatton and Smith, Jr. patents. Therefore, Applicant respectfully requests that the Examiner withdraw the present rejection.

Gilliam et al. and Smith, Jr.

The Examiner has rejected claims 38-45, 46-51, 52, 53-58, and 59 (independent claims underlined for convenience) under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 5,878,214 to Gilliam et al. and the Smith, Jr. patent, discussed above, stating that Gilliam et al. disclose all of the limitations of these claims except an invention map. The Examiner then asserts that Smith, Jr. discloses an invention map and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the Smith, Jr. map with the Gilliam et al. problem solving methodology.

Gilliam et al. disclose a method of solving one or more problems using a group of people assembled at a computerized meeting. One of the people is designated as a facilitator and the rest of the people are designated as resources. A problem is presented to the resources. The resources enter "springboards" into their computers, and a poll taken on the springboards. (A "springboard" is a resource's response to the problem.) Various types of ideas flow from the

polling and subsequent actions so as to result in solutions to the problem and actions to be implemented.

The Smith, Jr. disclosure is as discussed above.

Regarding independent claim 38, this claim requires among other things the steps of 1) instructing at least one participant on very specific statements relating to invention conception and 2) requesting the at least one participant to input into a computer ones of such statements. These limitations, like the limitations in claims 36 and 37 discussed above, are not merely nonfunctional descriptive statements. The fact that the resulting statements input into the computer themselves may be considered nonfunctional descriptive material does not influence the patentability of the underlying method of soliciting those statements.

Since the steps of independent claim 38 must be considered in their entireties, it is clear that Gilliam et al. patent fails to disclose or suggest all of the limitations of claim 38. Smith, Jr. fails to disclose these limitations as well. In addition, each of claims 39-45 includes a number of limitations not disclosed or suggested by either Gilliam et al. or Smith, Jr. Therefore, the cited combination cannot render claims 38-45 obvious.

Regarding independent claims 46 and 53, in addition to Gilliam et al. and Smith, Jr. being silent on the limitations of clauses (a)-(f) of claim 46 and clauses (b)(i)-(b)(vi) of claim 53, Gilliam et al. and Smith, Jr. are completely silent on the concept of an invention map that visually represents responsorial statements made by the at least one participant. Therefore, neither the Gilliam et al. nor Smith, Jr. patents discloses or even suggests the limitations of clauses (g) and (b)(7) of claims 46 and 53, respectively, directed to the generating of an invention map and, thus, cannot render obvious independent claims 46 and 53, nor claims 47-51 and 54-58 that depend therefrom. In addition, dependent claims 47-51 and 54-58 also include limitations not disclosed or suggested by Gilliam et al. or Smith, Jr.

Regarding independent claims 52 and 59, each of these claims require, among other things, computer-executable instructions that display various fields and specific field labels corresponding respectively to those fields. While the field labels themselves may be considered nonfunctional descriptive material, Applicant is not claiming the labels *per se*, but rather is claiming a computer readable medium and a computer containing instructions that display the specific labels in conjunction with input fields. None of the reference of record disclose or

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suggest the displaying these exact labels in the context of facilitating invention conception. Therefore, Applicant asserts that claims 52 and 59 are patentable over the references of record.

In view of the foregoing, Applicant respectfully requests that the Examiner withdraw the present rejection of claims 38-59.

Conclusion

In view of the foregoing, Applicant respectfully submits that claims 36-59, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,

IPCAPITAL GROUP, INC.

By: 

Morgan S. Heller II

Registration No.: 44,756

Downs Rachlin Martin PLLC

Tel: (802) 863-2375

Attachments:

Definitions of "solicit"
Synonyms of "solicit"

BTV.460084.1